

Appl. No. 10/718,161

Reply Filed: May 16, 2007

Reply to Office Action of: November 16, 2006

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings includes changes to Figs. 2-5. These sheets replace the original sheets including Figs. 2-5. Figs. 1 and 6 are unchanged. Changes are shown in the attached annotated copies of the original sheets.

REMARKS

In response to the Office Action of November 16, 2006, the Applicant submits this Reply. In view of the following remarks, reconsideration is requested.

Drawings

The Office Action required several changes in the drawings. Of these requirements, Applicant traverses the requirement to label the item corresponding to reference number 80. Reference number 80 refers to an “end point” which is illustrated by a line and not a box that can be easily labeled.

Rejection Under 35 U.S.C. §101

Claims 1-7 were rejected under 35 U.S.C. §101 as being directed to nonstatutory subject matter. The rejection is traversed.

The Office Action states that “when functional descriptive material is recorded on some computer-readable medium, it become structurally and functionally interrelated to the medium and will be statutory in most cases. . . .”

Claim 1 clearly recites “a computer readable medium” and “computer program instructions stored on the computer readable medium”. Therefore, the claims are not directed to a computer listing or computer program *per se*, but instead an “article of manufacture” under 35 U.S.C. §101. See In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995). The remaining dependent claims 2-7 incorporate this structure. Therefore the rejection is traversed.

Rejection Under 35 U.S.C. §112, second paragraph

Claims 1-7 were rejected under 35 U.S.C. §112, second paragraph. The Office Action asserts that the claims are drawn to “product-by-process claims.” The rejection is traversed.

First, the claims are not “product-by-process” claims. The definition of a product by process claim, according to the Office Action, is one where the product is defined at least in part in terms of the method or process *by which it is made*. The article of manufacture claimed in claims 1-7 is a computer program product that includes a computer readable medium with computer program instructions stored thereon. The method steps in claims 1-7 do *not* describe the process by which the claimed *computer program product* is made, but instead describe the

process performed when the computer program instructions are executed. Thus, claims 1-7 are not product by process claims. The rejection is therefore traversed.

Moreover, the Office Action appears to be relying on in re Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) for concluding that product-by-process claims are categorically indefinite. Such a conclusion is not the law. Instead, product-by-process claims are recognized as a valid way of defining an invention, as recognized by the Court of Appeals for the Federal Circuit in several decisions, including but not limited to SmithKline Beecham v. Apotex, 439 F.3d 1312 (Fed. Cir. 2006), Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991) and Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834 (Fed. Cir. 1992), and the U.S. Supreme Court in Cochrane v. Badische Anilin & Soda Fabrik, 111 U.S. 293 (1884). There is nothing in these cases to suggest that such claims are categorically indefinite under 35 U.S.C. §112, second paragraph. Therefore the rejection is further traversed for not being in accordance with law.

Rejections Under 35 U.S.C. §103

Claims 1-7 were rejected under 35 U.S.C §103 in view, on the one hand U.S. Patent 5,388,197 (“Rayner”) and U.S. Patent 5,594,856 (“Girard”), and on the other hand U.S. Patent Publication 2004/0117730 (“Ibrahim”) and Girard. The rejection is traversed.

The rejection is apparently based on the premise, albeit incorrect, that the claims are directed to a product-by-process. As discussed above, the claims are not directed to a product by process. Therefore, the rejection is traversed.

Moreover, none of the process steps recited in the claims have been addressed by the Office Action. Because the Office Action does not address the differences between the claimed invention and the prior art as required by KSR v. Teleflex, ___ U.S. ___ (2007) the rejection is incomplete and not in accordance with law. Therefore, the rejection is traversed.

To the extent the process steps have been ignored due to reliance on any judicial precedent not cited in the Office Action, an explanation is requested. Because the claims are not product-by-process claims, various judicial decisions related to product-by-process claims, such as SmithKline Beecham v. Apotex, 439 F.3d 1312 (Fed. Cir. 2006), Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991) and Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834 (Fed. Cir. 1992) are not applicable.

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The Office Action concludes with a quotation from in re Marosi, suggesting that it is the Applicant's burden to "come forward with evidence [of the differences] between the claimed product and the prior art product." However, this shift of the burden of proof is only applicable when the Office Action "provides a rationale which supports the conclusion that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process." Because the claims in this application are not product by process claims, in re Maroni simply does not apply.

In view of the foregoing, both of the rejections under 35 U.S.C. §103 are traversed.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this reply, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, please charge any fee to **Deposit Account No. 50-0876**.

Respectfully submitted,

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Attachments (3 replacement sheets; 3 annotation sheets)

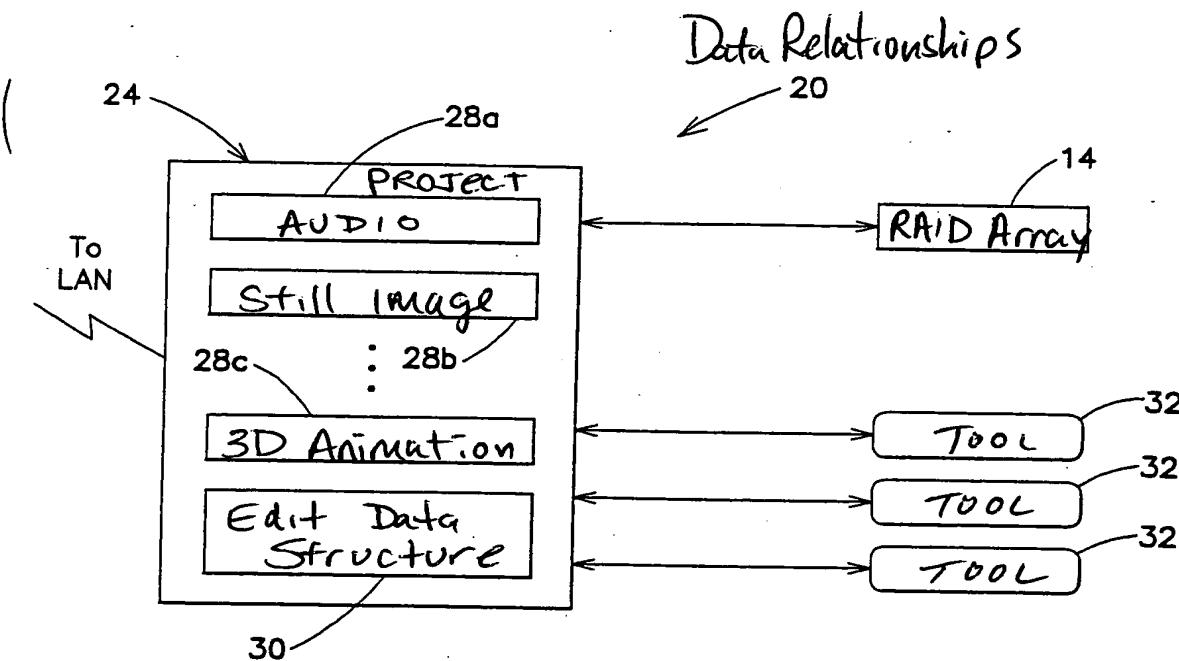


Fig. 2

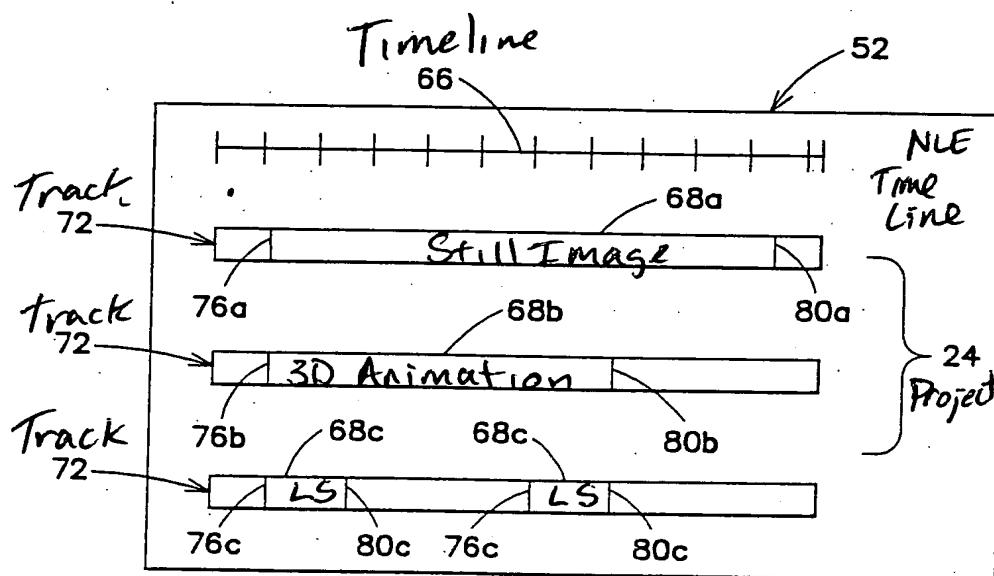


Fig. 4

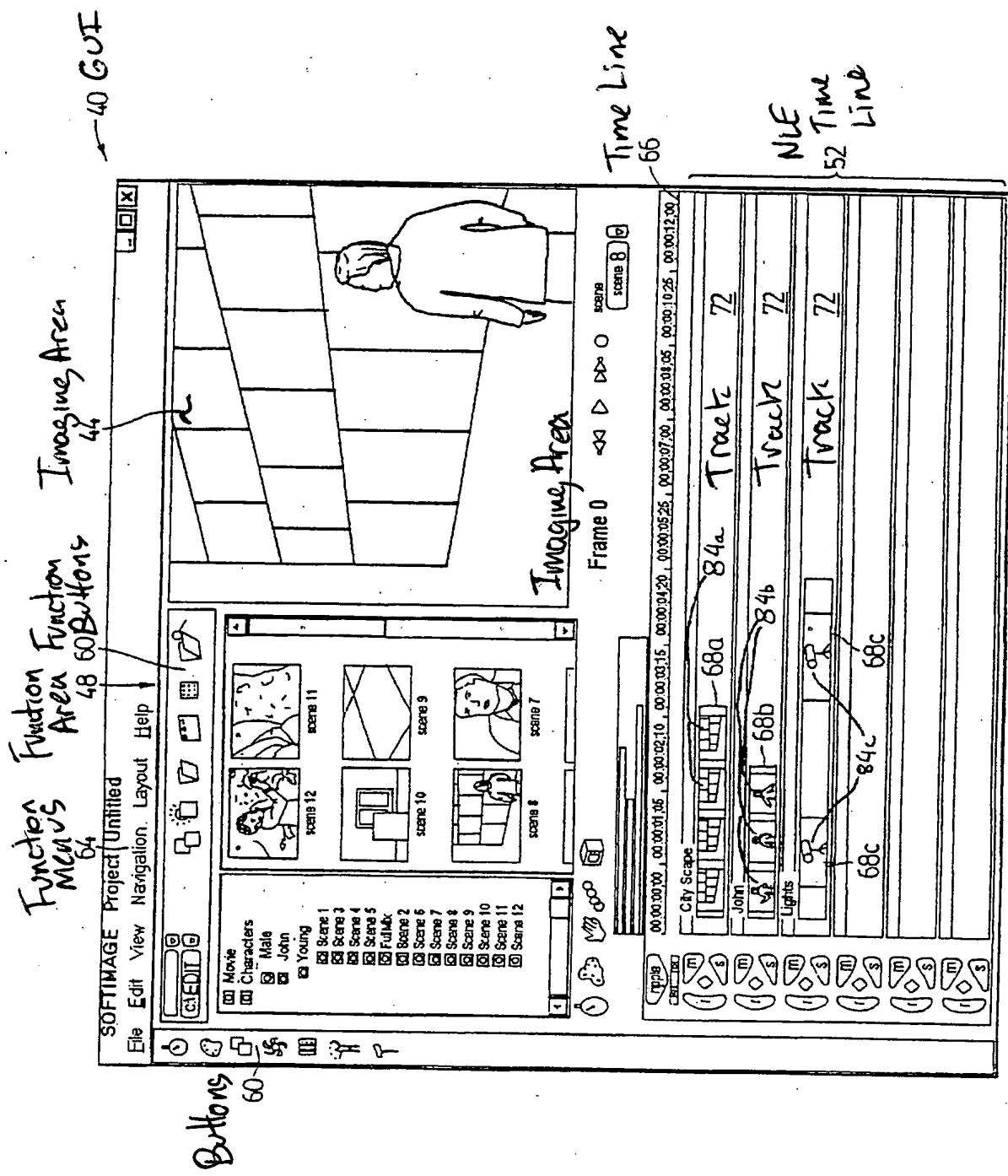


FIG. 3

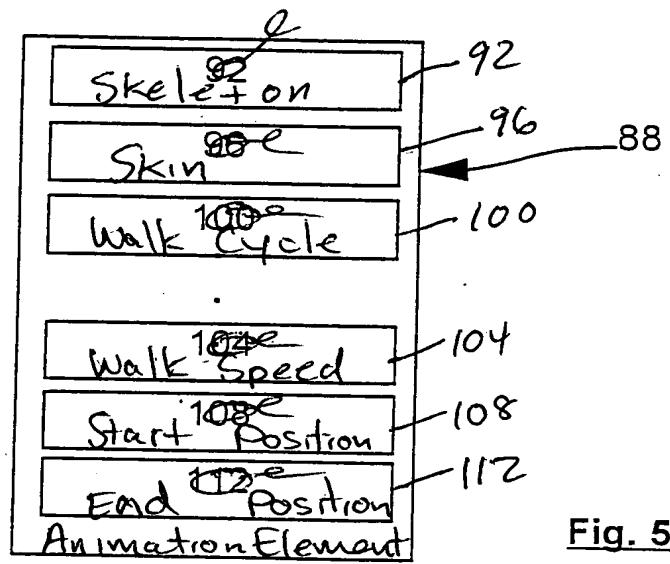


Fig. 5